



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,739	11/20/2001	Brendan Hinchey	DEKM:177US	9652

7590 10/04/2004  
FULBRIGHT & JAWORSKI L.L.P.  
A REGISTERED LIMITED LIABILITY PARTNERSHIP  
SUITE 2400  
600 CONGRESS AVENUE  
AUSTIN, TX 78701

EXAMINER

FOX, DAVID T

ART UNIT PAPER NUMBER

1638

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/989,739

Applicant(s)

HINCHEY ET AL.

Examiner

David T. Fox

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-89 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 12-16, drawn to a primer comprising at least 135 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 24.33, for example.
- II. Claim 2, drawn to a probe comprising at least 250 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 24.3, for example.
- III. Claim 3, drawn to 400-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 23.2, for example.
- IV. Claim 4, drawn to 750-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 23.1, for example.
- V. Claim 5, drawn to 1000-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 24.1, for example.
- VI. Claim 6, drawn to 1500-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 23.6, for example.
- VII. Claim 7, drawn to 1750-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 23.2, for example.
- VIII. Claim 8, drawn to 2000-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 23.1, for example.
- IX. Claim 9, drawn to 2250-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 24.1, for example.

Art Unit: 1638

- X. Claim 10, drawn to 2500-2547 nucleotides of a glutamine synthetase promoter, classified in class 536, subclass 23.6, for example.
- XI. Claims 11, 17-34, 57-59, and 62-73, drawn to an entire glutamine synthetase promoter, methods of plant transformation, and plants transformed therewith, classified in class 800, subclass 278, for example.
- XII. Claims 35-56, 60-61 and 74-89, drawn to methods of crossing a plant transformed with an entire glutamine synthetase promoter, and the resultant progeny, classified in class 800, subclass 260, for example.

The inventions are distinct, each from the other because:

Inventions I-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, and different modes of operation. Each invention is drawn to a biochemically divergent nucleotide sequence or sequence portion. Furthermore, the shorter sequences of Groups I-II are insufficient to function as promoter sequences, and have the different function of being probes or primers, than the longer sequences of Groups III-XI.

Applicants are reminded that nucleotide sequences comprising distinctly different runs of base pairs are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and

distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Applicant is required to select a single nucleotide sequence corresponding to said Group. This requirement is not to be construed as a requirement for an election of species, since each nucleotide sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention.

Each of inventions I-X and each of XI-XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects. The inventions of Groups XI and XII require plant transformation and plant tissue culture methods, as well as whole plants, each not required by the isolated nucleic acids of Groups I-X. The inventions of Groups I-X involve isolated promoter sequences or subsequences, which could be used in a materially different process other than a process of plant transformation, such as a hybridization- or PCR-mediated process for determining the presence of orthologous sequences in other non-transformed plant species.

Inventions XI and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can

Art Unit: 1638

be used in a materially different process, such as the growth of the transformed plant in a field or greenhouse for the production of a recombinant product therein, or for the production of a harvestable plant part exhibiting desired agronomic properties.

Furthermore, the invention of Group XII requires genetically and physiologically divergent second plants to be used as breeding partners, which second plants contain different genes encoding different products and conferring different traits than the transformed plant of Group XI. Moreover, the invention of Group XII requires breeding steps and crossing protocols not required by Group XI or any other group. Additionally, the invention of Group XII requires hybridization or PCR-mediated methods for determining the presence of the transgene in the progeny plants, not required by the invention of Group XI or any other group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1638

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

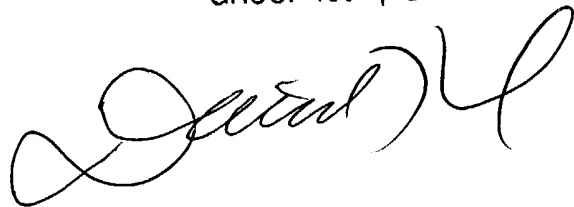
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

September 29, 2004

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP ~~100~~-1638

A handwritten signature in black ink, appearing to read "David T. Fox", written over the printed name and title.